

REMARKS

The Examiner has rejected claims 1-16, 29-33, and 50-55. Claims 17-28 and 34-49 have been cancelled. Claims 1, 29, and 50 have been amended. Claims 1-16, 29-33, and 50-55 are pending.

Support for the amendment may be found, for example, at paragraph 65 of the specification.

With respect to all amendments and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

I. Examiner Interview

Applicants respectfully thank the Examiner for the interview of January 11, 2004, in which the present claim amendments and U.S. Patent No. 5,314,401 to Tepper (hereinafter referred to as "Tepper") were discussed.

II. Response to Rejection under 35 U.S.C § 102(b)

The Examiner has rejected claims 1, 5-9, 29, 31-33, and 50-55 under 35 U.S.C. §102(b) as being anticipated by Tepper.

Claim 1 has been amended to recite "wherein said generator is configured to adjust the amplitude of said applied electromagnetic energy in response to said measured field strength, and said applicator is configured to apply electromagnetic energy with said adjusted amplitude from said generator." Claim 29 has been amended to recite "a detector configured to: measure the electromagnetic energy applied by said applicator, and produce a response signal in response to said measured electromagnetic energy; and a second circuit configured to apply electromagnetic energy by varying the amplitude of said applied electromagnetic energy as a function of said response

signal.” Claim 50 has been amended to recite “measuring said applied electromagnetic energy” and “applying electromagnetic energy by varying the amplitude of said applied electromagnetic energy as a function of said response signal.”

Tepper does not anticipate the amended claims for at least the following reasons:

First, Tepper does not disclose changing the amplitude of the electromagnetic field in response to a measured field strength. Instead, Tepper describes only producing an alarm signal based on the sensed field strength. Specifically, Tepper states:

[t]he field sense amplifier senses the electromagnetic fields generated during the transducer activation, and provides feedback to the PEMF processor for monitoring the PEMF operation. The PEMF processor causes appropriate monitoring data to be stored in the data memory 44, and will cause an alarm signal in the case of a malfunction. (Emphasis added.) Col. 8, lines 35-44.

The amplitude of electromagnetic energy is not adjusted or varied in response to the alarm signal.

Second, claims 1, 29, and 50, as amended, foreclose changing the amplitude of the electromagnetic energy by turning off the applied electromagnetic energy in response to measured energy, as suggested by the Examiner. Instead, the amended claims require that electromagnetic energy having an adjusted amplitude is applied after the electromagnetic energy has been measured. This amendment expressly forecloses cases in which the applicator turns off in response to an alarm signal.

Third, the secondary winding does not change the amplitude of applied electromagnetic energy in response to measured field strength. In the final rejection dated August 13, 2004, the Examiner asserts that the secondary winding is used to tailor the electromagnetic field in response to the measured electromagnetic field, stating that “the secondary winding is ‘used to tailor the parameters of the electromagnetic field,’ col. 2 at 56-68.” Contrary to the Examiner’s position, the secondary winding does not adjust the amplitude of the applied electromagnetic energy in response to measured signal. In Figure 4, the secondary winding is linked to a battery charger connector and

energy recovery capacitance 84. The secondary winding does not measure the electric field, but merely recovers electromagnetic energy by induction, thereby preserving the life of the battery. The sense winding measures the applied electromagnetic field, but is not linked in any way to changing the amplitude of the applied electromagnetic energy.

Fourth, disabling the applied field is not inherent in the teachings of Tepper. The Examiner's burden in making such a rejection are summarized in M.P.E.P. § 2112:

In relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. M.P.E.P. § 2112 (emphasis in original).

Moreover, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." Id. (quoting In re Oelrich, 212 USPQ 323, 326 (CCPA 1981). Disabling the applied field does not necessarily flow from the teachings of Tepper, as Tepper does not provide even a hint that disabling the applied field would occur.

For all the reasons stated above, Tepper fails to anticipate the claims. Applicants respectfully request that this ground for rejection be withdrawn.

III. Rejections under 35 U.S.C. §103(a)

A. Claims 2-4 and 30

The Examiner has rejected claims 2-4 and 30 under 35 U.S.C. §103(a) over Tepper.

Claims 2-4 variously depend from and include all the limitations of claim 1. Claim 30 depends from and includes all the limitations of claim 29. Tepper does not satisfy the requirements for obviousness. First, Tepper does not meet every limitation of claims 1 and 29, as amended. Second, Tepper does not provide the requisite motivation to modify its teachings to meet the

limitations of the claims. Third, Tepper also does not provide the requisite reasonable expectation of success to modify its teachings to meet the limitations of the claims.

Because Tepper fails to make a *prima facie* case for obviousness, Applicants respectfully request that this ground for rejection be withdrawn.

B. Claims 10-15

The Examiner has rejected claims 10-15 over Tepper in view of U.S. Patent No. 4,619,264 to Singh (hereinafter referred to as "Singh").

Claims 10-15 variously depend from claim 1, and include all limitations of claim 1. Tepper does not satisfy the requirements for obviousness. First, neither Tepper nor Singh teach every limitation of the claims, as amended. Second, neither Tepper nor Singh provide the requisite motivation to combine their teachings to meet every limitation of the claims. Finally, neither Tepper nor Singh provide a reasonable expectation of success to modify their teachings to meet the limitations of the claims.

Because Tepper and Singh, taken together, fail to make a *prima facie* case for obviousness, Applicants respectfully request that this ground for rejection be withdrawn.

IV. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and



Application No.: 09/994,598
Preliminary Amendment for RCE

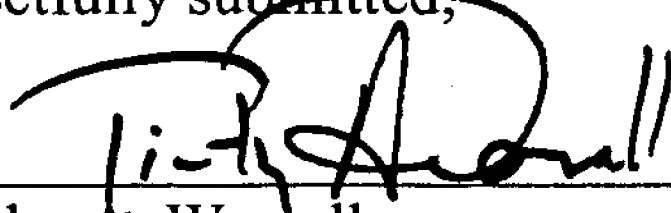
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Docket No.: 425282000201

authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 425282000201. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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